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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/590,584  | 06/08/2000  | Tai A. Ly            | 4000/10             | 1223             |
| 35795   | 7590        | 01/14/2005           | EXAMINER            |                  |
| JONATHAN T. KAPLAN<br>ATTORNEY AT LAW<br>140 NASSAU STREET<br>NEW YORK, NY 10038-1501 |             |                      | THOMPSON, ANNETTE M |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2825                |                  |

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/590,584             | LY ET AL.           |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | A. M. Thompson         | 2825                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 24 March 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-3,6-24,27,28,31 and 32 is/are allowed.
- 6) Claim(s) 4,5,25,26,29,30 and 33-40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

|   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Reissue Application***

Applicants' Amendment to 09/590,584 has been reviewed and remarks considered. The specification and drawings are amended. Claims 4-6, 10, 12, 13, 14 are amended. Claims 35-40 are added. Claims 1-40 are pending.

1. New grounds of rejection necessitate this second non-final action on the merits.

### ***Drawings***

2. Applicants' replacement drawing sheets for Figures 1-4 filed 24 March 2004 are approved.

### ***Specification***

#### ***Incorporation By Reference***

3. The attempt to incorporate subject matter into this application by reference to Behavioral Synthesis Methodology for HDL-Based Specification and Validation by D. Knapp et al., and Scheduling using Behavioral Templates by T. Ly et al. is improper for the following reasons: 1) Applicants attempt to incorporate by reference publications with publication dates that are later (June 12-16, 1995) than the filing date of the original application (May 12, 1995) 2) Further, even if the incorporation of the publications were proper, Applicants would not be entitled to amend the specification to include the texts of the entire publication. Applicant is only entitled to that portion of the publication that contains the subject matter specifically referenced in the application. In the instant case, for the D. Knapp et al. publication, the subject matter would be scheduling modes that allow a greater degree of freedom in assigning states in a

schedule; for the D. Gajski et al. publication, the subject matter would be control data flow graphs. Reference MPEP §608.01(p), I. Incorporation By Reference.

4. The amendment filed 24 March 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The Appendices and the new drawings.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 251***

5. Claims 35-40 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

Applicants' specification, without the improperly incorporated appendices does not include support for the term "clock statement".

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the **first** paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 35-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term ***clock statement*** is not enabled by Applicants' specification.

8. The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 4, 5, 25, 26, 29, 30, 33 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Pursuant to claims 4 and 5, it is well known in the art of integrated circuit design that wait statements and Verilog @posedge/@negedge statements are different and use different code terms. Applicants' specification recognizes and includes this distinction (see e.g. page 25, line 1-5). Therefore, Applicants' confuses the claim language by reciting that wait statements *use* Verilog @positive edge or @negative edge statements, when it is well known in the art of integrated circuit design that wait statements explicitly use "Wait" as the keyword term. Similarly confusing are claims 25, 26, 29, 30, 33, and 34 which recite that "wait statements are clock statements (i.e. @posedge). Examiner suggests using the phrase "***transition(s) on***" instead of "use" or "are" to precisely and accurately claim Applicants' invention.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications should be directed to Examiner A.M. Thompson whose telephone number is (571) 272-1909. The Examiner can usually be reached Monday thru Friday from 8:00 a.m. to 4:30 p.m..

Art Unit: 2825

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11. Responses to this action should be mailed to the appropriate mail stop:

Mail Stop \_\_\_\_\_

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or faxed to:

(703) 872-9306, (for all OFFICIAL communications intended for entry)

